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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,992	12/12/2000	Anuj Jain	ERIC P12549	3370
7590 10/06/2004				
DAVID E. BENNETT COATS & BENNETT P.L.L.C. 1400 CRESCENT GREEN SUITE 300 CARY, NC 27511		EXAMINER NAJJAR, SALEH		
		ART UNIT 2157		

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/734,992	JAIN, ANUJ	
	<b>Examiner</b>	<b>Art Unit</b>	
	Saleh Najjar	2157	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36-41 is/are allowed.
- 6) ☒ Claim(s) 26-30, 35, 42-46, 51, 52 and 54-68 is/are rejected.
- 7) ☒ Claim(s) 31-34, 47-50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. This action is responsive to the communication filed on June 23, 2004. Claims 26-68 are pending. Claims 26-68 represents a method, system and product for controlling inclusion of email content.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26, 28-30, 35, 42, 44-46, 51-52, 54-57, 59-63, and 65-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobata et al., U.S. Patent No. 6,591,367.

Kobata teaches the invention as claimed including a method and system for preventing unauthorized distribution of email message sin a network (see abstract).

As to claim 26, Kobata teaches a method of controlling retransmission of email message content in an email message by a recipient of the email message, the method comprising:

inserting control information into a first email message to control retransmission of the email message content in a second email message originating from a recipient of the first email message, without deleting the recipient's copy of the first e-mail message (see col. 9, lines 1-10, Kobata discloses that the forwarding of an email message is controlled); and transmitting the first email message to the recipient (see figs. 1-5; col. 9, lines 30-45, Kobata Ogilvie discloses that a control code included in the email message controls distribution of the email content).

As to claim 28, Kobata teaches the method of claim 26, wherein the second email message comprises a forwarding message, and wherein the control information controls inclusion of the selected portions of the email message content in the forwarding message (see col. 9, line 10).

As to claims 29-30, Kobata teaches the method of claim 26, wherein the control information causes at least a portion or the entire of the email message content to be excluded from the second email message (see col. 9, lines 1-67, Kobata discloses that at least a portion of the email message is excluded from being forwarded).

Claims 35, 42, 44-46, 51-52, 54-57, 59-63, and 65-68 do not teach or define any new limitation above claims 26, 28-30 and therefore are rejected for similar reasons.

5. Claims 27, 43, 53, 58, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobata further in view of Thorne et al., U.S. Patent No. 5,958,005.

Kobata teaches the invention substantially as claimed including a method and system for preventing unauthorized distribution of email message sin a network (see abstract).

As to claim 27, Kobata teaches the method of claim 26.

Kobata does not explicitly teach the claimed limitation wherein the second email message comprises a reply message, and wherein the control information controls

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inclusion of the email message content in the reply message. Kobata does teach these features for controlling the forwarding of the email (see col. 9-10).

However, Thorne teaches a method and system for including security parameters in an email message (see abstract). Thorne teaches wherein the second email message comprises a reply message, and wherein the control information controls inclusion of the email message content in the reply message (see col. 10, lines 60-67; col. 11, lines 1-10, Thorne discloses security code for replying to an email message without including the content of the original message).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kobata in view of Thorne so that reply messages to an email are controlled. One would be motivated to do so to limit unnecessary email message content.

Claims 43, 53, 58, and 64 do not teach or define any new limitations above claim 27 and therefore are rejected for similar reasons.

6. Claims 31-34, and 47-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 36-41 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or disclose neither singly nor in combination the claimed limitation of selecting by the first user portions of the email message content to be excluded from being distributed.

9. Applicant's arguments with respect to claims 26-68 have been considered but are moot in view of the new ground(s) of rejection.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saleh Najjar whose telephone number is (703) 308-7613. The examiner can normally be reached on Monday-Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ario Etienne*, can be reached on (703) 308-7562.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The central official fax number for the group is (703) 872-9306.



Saleh Najjar

Primary Examiner / Art Unit 2157